THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte PABLO L. SANCHEZ

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Appeal No. 96-3616
Application 08/368,857[1]

_____

ON BRIEF

_____

Before ABRAMS, FRANKFORT and NASE, ***Administrative Patent Judges***.

FRANKFORT, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, all of the claims pending in this application.

Appellant's invention relates to an athletic shoe or sneaker

[1]Application for patent filed January 5, 1995.

for use by a bodybuilder during exercises that are intended to strengthen the thigh and calf muscles. A copy of claims 1 through 4 on appeal appears in the Appendix to appellant's brief (Paper No. 7).

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Lawlor	4,494,321	Jan. 22, 1985
Agnew	5,224,279	Jul. 06, 1993
Anderie et al. (Anderie) (International Patent Publication)[2]	WO 90/04933	May 17, 1990
Neugebauer (German Patent)[2]	DE 4,100,156	Jul. 09, 1992

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Anderie.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Anderie in view of Neugebauer.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Anderie in view of Neugebauer as applied to

[2] A translation of each of these foreign language documents has been prepared for the U.S. Patent and Trademark Office, and a copy of each translation is attached to this decision.

claims 1 and 2 above, and further in view of Agnew.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Anderie, Neugebauer and Agnew as applied to claim 3 above, and further in view of Lawlor.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 8, mailed March 28, 1996) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 7, filed March 4, 1996) and reply brief (Paper No. 9, filed April 24, 1996) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that none of the

examiner's rejections will be sustained. Our reasoning in support of this determination follows.

Looking first at the examiner's rejection of claim 1 under § 102(b), we are in agreement with the examiner that the groove (21) of Anderie is readable as the "first cavity" set forth in appellant's claim 1 on appeal. Note also that the translation (page 7, lines 11-20) indicates that the support strap (3) therein may also "extend through the sole of the shoe." We also agree with the examiner that the stationary support strap (3) of Anderie includes hook and loop fastener (e.g., Velcro) closure or securement parts on the strap (see Figure 3, parts 31, 32 and translation, page 9). Where we part company with the examiner's position is in the requirement of claim 1 that the stationary strap be "built into said upper shoe." As pointed out by appellant (brief, page 10), the strap (3) of Anderie is secured to the outside of the shoe at the edge or upper side of the sole (2). See Figure 1 of Anderie. In contrast, Figures 2, 4 and 7 of appellant's drawings clearly show the strap (24) as being built into the upper shoe (14) in the area of the heel and ankle

portions of the shoe therein. As an additional item, we observe that claim 1 requires the strap to extend "about an ankle of the bodybuilder." When this limitation is viewed in light of appellant's disclosure, it is clear that the strap (24) of appellant's shoe extends entirely about the ankle portion of the shoe and can be snugly secured about the ankle of a bodybuilder so as to provide support for the ankle during exercises to strengthen the thigh and calf muscles (see, e.g., Fig. 7). The strap (3) of Anderie does not extend "about" the ankle of either the shoe or the user in this manner. Thus, in the present case, all the limitations of appellant's claim 1 are not found in Anderie, either expressly or under principles of inherency, and the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) will not be sustained.

Turning to the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103 as being unpatentable over Anderie in view of Neugebauer, we must agree with appellant that there is no reasonable teaching, suggestion, or incentive in the applied references which would have led one of ordinary skill in the art to attempt to provide the shoe of Anderie with both the strap (3)

therein and the strap or belt (16) of Neugebauer. The shoe of Neugebauer, with its inserts or underlays (11-13) and strap or belt (16), is clearly a distinct system from that of Anderie for coping with the same or similar problem of ankle injury due to bending the ankle outwards. Since we have determined that the examiner's conclusion of obviousness is based on a hindsight

reconstruction using appellant's own disclosure as a blueprint to arrive at the claimed subject matter, it follows that we will not sustain the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103 based on Anderie and Neugebauer.

Having reviewed the patents to Agnew and Lawlor also applied by the examiner, we find nothing therein which overcomes or supplies the deficiencies of the basic combination of Anderie and Neugebauer as discussed above. Accordingly, it follows that the examiner's respective rejections of claims 3 and 4 under 35 U.S.C. § 103 will likewise not be sustained.

Based on the foregoing , the decision of the examiner rejecting claims 1 through 4 under 35 U.S.C. § 103 is reversed.

Appeal No. 96-3616
Application 08/368,857

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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